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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CORY O. NYKOLUK and DAVID D. MITTLEMAN

Appeal 2009-007436
Application 10/688,447
Technology Center 3700

Decided: June 17, 2010

Before: LINDA E. HORNER, JOHN C. KERINS, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Cory O. Nykoluk et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 30, 32-35, and 38-50. Claim 31 has been objected to and claims 53-56 have been allowed. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

THE INVENTION

Appellants' claimed invention is a hand towed piece of baggage having a towing handle that is pivotally attached to an arm portion of a towing member. Spec. 1:3-7. Claim 30, reproduced below, is representative of the subject matter on appeal.

30. A hand towed piece of baggage comprising:
 - a piece of baggage having a top and a bottom;
 - a set of wheels rotationally mounted towards said bottom of said piece of baggage;
 - a receptacle providing an opening in said top of said piece of baggage;
 - an arm portion retractably engaged to said piece of baggage and having an adjustable axial length extending between opposite proximal and distal ends, said proximal end being operatively secured to said piece of baggage and said distal end positionable between an extended position and a retracted position through said receptacle, wherein in said retracted position said distal end is closer to said piece of baggage than in said extended position;
 - a connector fixedly mounted to said distal end; and
 - a towing handle having a hand grip, the towing handle being separately provided from the connector and engaged to the connector such that said hand grip can pivot relative to said connector about a pivot axis that intersects the hand grip when said arm portion is in said extended position, and such that said towing handle grip is retracted at least partially into said receptacle when said arm portion is in said retracted position.

THE REJECTIONS

Appellants seek review of the following rejections by the Examiner:

1. Rejection of claims 30, 34, 35, and 42-47 under 35 U.S.C. § 102(b) as anticipated by Williams (US 4,538,709).¹
2. Rejection of claims 30, 34, 35, and 38-47 under 35 U.S.C. § 103(a) as unpatentable over Sadow (US 5,890,570), Liang (US 5,464,080), and Sparks (US 853,566).
3. Rejection of claims 32 and 33 under 35 U.S.C. § 103(a) as unpatentable over Sadow, Liang, Sparks, and Browning (US 3,606,372).
4. Rejection of claims 48, 49, and 50 under 35 U.S.C. § 103(a) as unpatentable over Sadow, Liang, Sparks, and Miyoshi (US 5,908,093).

Rejection of claims 30, 34, 35, and 42-47 under 35 U.S.C. § 102(b) as anticipated by Williams

The Examiner's determination of anticipation by Williams is based in part on the finding that Williams discloses a connector (tubular section 50a) "fixedly mounted" to the distal end of an arm portion (tubular sections 50b and 50c of telescoping pole 50) as called for in independent claim 30. Ans. 3. In reaching this finding, the Examiner interpreted the term "fixedly" as not requiring the connector (tubular section 50a) to be immovable with respect to the distal end of the arm portion (tubular section 50b). Ans. 3, 7.

Appellants argue that "fixedly" means immovable, and that tubular section 50a of telescoping pole 50 of Williams is not fixedly mounted to the

¹ Claim 37 is not part of this appeal. Appellants mistakenly list claim 37 as appealed in the headings of their arguments (App. Br. 10, 20; Reply Br. 3); however, Appellants do not list claim 37 as appealed in the *Status of Claims* of their Appeal Brief (App. Br. 4) and correctly note that claim 37 is cancelled in the *Status of Claims* of their Reply Brief (Reply Br. 2). Claim 37 is not rejected as anticipated by Williams in the Office Action that is the subject of this appeal. Office Action, February 27, 2008, page 3.

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distal end of an arm portion because tubular section 50a moves telescopically with respect to the remaining portions of telescoping pole 50 (i.e., tubular sections 50b, 50c). App. Br. 21; Reply Br. 4.²

The issue before us is:

Does independent claim 30 require the connector to be immovably mounted to the distal end of the arm portion, and if so, does Williams disclose such a connection?

We cannot agree with the Examiner's interpretation that "fixedly mounted" does not require the connector to be immovable with respect to the distal end of the arm portion. Appellants' Specification does not provide a lexicographical definition of "fixedly." "Fixed" is commonly understood to mean "firmly in position, stationary." *The American Heritage® Dictionary of the English Language*, Boston: Houghton Mifflin, 2007, *Credo Reference*, 12 Dec. 2007, last accessed on 2 June 2010 at <<http://www.credoreference.com/entry/hmdictenglang/fixed>> (definition 1). Appellants' Specification describes the connector 54 as "secured to the free end 38 [the distal end] of telescoping section 30 by a pair of screws or rivets 78 passing through the holes 39 of the free end 38 into the blind-holes 70 of the connector 54." Spec. 11:19-22; fig. 6. Thus, the description of the attachment of connector 54 to the distal end of the telescoping portion 30 found in Appellants' Specification is consistent with the commonly understood meaning of fixed as "stationary." We find no support in the Specification for the Examiner's position (Ans. 7) that Appellants' counter

² The Docketing Notice mailed April 10, 2009, incorrectly states that no Reply Brief was filed. The Office received Appellants' Reply Brief on September 24, 2008, and the Examiner noted it in a communication dated January 7, 2009. The Board has considered Appellants' Reply Brief in reaching its decision in this appeal.

bore 52, which is rotatable relative to the distal end of telescoping portion 30, is the “connector” of claim 30. Spec. 10:7-9 (referring to “counter-bore 52” and “connector 54”); fig. 4. As such, we interpret independent claim 30 to require the connector to be mounted stationary to the distal end of the arm portion.

Williams’s tubular section 50a is rotatably connected to tubular section 50b of telescoping pole 50. Williams, figs. 2, 5 (note 90° rotation of handle 20 between these figures). Hence, Williams’s tubular section 50a (connector) is not mounted so as to be stationary with respect to the distal end of tubular section 50b (the arm portion) as required by independent claim 30. As such, the rejection of claim 30 is in error, and the rejection of claims 34, 35, 37, and 42-47 is also in error by virtue of their dependence, directly or indirectly, from claim 30.

Rejections under 35 U.S.C. § 103(a)

The Examiner found that Sadow discloses all aspects of the invention of claims 30, 34, 35, and 38-47 except: (1) the hand grip pivoting relative to the distal end of an arm portion, and (2) a connector fixedly mounted to the distal end of an arm portion. Ans. 4. The Examiner concluded that it would have been obvious to modify Sadow to include a rotatable hand grip, as taught by Liang, in order “to provide an alternative rotating handle.” *Id.* The Examiner further concluded it would have been obvious to modify Sadow’s device to include a connector as taught by Sparks, “to enable one to install the handle properly.” *Id.*

Appellants argue that the Examiner’s rationale for the modifications based on the teachings of Liang and Sparks is insufficient to explain why a person of ordinary skill in the art would have made such modifications.

App. Br. 15-18; Reply Br. 6-8.

The issue before us is:

Is the proposed combination based upon a sufficient reason with a rational underpinning to explain why a person of ordinary skill in the art would have modified the device of Sadow to reach the subject matter of claim 30?

Sadow discloses a wheeled carry-on case 11 having a major longitudinal edge (defined by front wall 28) provided with two ground-engaging wheels 14, and at least one of the minor longitudinal edges (e.g., side wall 22) provided with two ground-engaging wheels 16. Sadow, col. 1, ll. 62-65; col. 2, ll. 50-53, 62; col. 3, ll. 8; fig. 1. Wheeled carry-on case 11 includes a single retractable handle 20 that is usable to guide wheeled movement in a direction substantially parallel to the front face (front wall 28) of the carry-on case 11, with the handle 20 rotatable 90 degrees to guide wheeled movement in a second direction perpendicular to the first direction. Sadow, col. 1, ll. 33-46; col. 2, ll. 43-44, 55. For motion perpendicular to the major longitudinal edge, a user positions handle 20 parallel to front wall 28, tilts the carry-on case 11 to place the weight over wheels 14, and pulls carry-on case 11 in a direction perpendicular to front wall 28.³ Sadow, col. 3, ll. 6-10; fig. 1 (dotted line position of handle 10). For motion parallel to the major longitudinal edge (lateral motion), the user positions handle 20 perpendicular to front wall 28, tilts the carry-on case 11 to place the weight over one of the sets of wheels 16, and pushes or pulls the carry-on case 11 in a direction parallel to the major longitudinal axis. Sadow, col. 3, ll. 11-17; fig. 1 (solid line position of handle 20).

³ Wheels 14 are attached to carry-on case 11 such that they do not contact the ground when the case is upright, i.e., not tilted. Sadow, fig. 2.

Liang discloses a steering mechanism for wheeled luggage designed both to apply only a pulling force (and not torque) to the luggage to facilitate steering, and to be attached below the center of gravity of the luggage to increase stability (reduce tippage of the luggage). Liang, col. 1, ll. 5-10, 44-51. Liang's suitcase 10 includes a handle (member 34) comprised of a first rod 54 interconnected to a second rod 56 having a rotatably mounted handle 42. Liang, col. 3, ll. 43-45; figs. 2, 6. Handle 42 includes a handle-securing ridge 70 configured for rotatable mounting about a second retaining lip 72 on the distal end of second rod 56 so that handle 42 rotates about the longitudinal axis of second rod 56. Liang, col. 4, ll. 51-57; fig. 10. Handle 42 is rotatably mounted to second rod 56 so that little if any torque is applied to suitcase 10 due to a user's application of force to the handle (member 34), thus reducing the chance of tipping during steering along a curved path. Liang, col. 1, ll. 41-45 (only a pulling force is applied); col. 3, ll. 48-59.

Sadow's carry-on case 11 is tilted during movement in each of two perpendicular directions, requiring the application of torque to the bag via the handle (Sadow, col. 3, ll. 6-17; fig. 1), while in contrast, Liang's rotatable handle is part of a design intended to prevent the application of torque to the baggage (Liang, col. 1, ll. 5-10, 41-51; col. 3, ll. 48-59). A person of ordinary skill in the art would recognize that a modification of Sadow's handle 20 to be rotatable as taught by Liang would hinder the application of force needed to tilt Sadow's carry-on case 11 for movement. Given this, we agree with Appellants (App. Br. 17) that the Examiner's rationale of providing "an alternative rotating handle" (Ans. 4) does not adequately explain why a person of ordinary skill in the art would make such a modification to the carry-on case 11 of Sadow.

Regarding the addition of a connector to Sadow's device as taught by Sparks, Sparks discloses an improvement in the attachment of handles to spading forks, shovels, or similar instruments so that the handle is rigidly united to the shank with a minimum of parts and labor. Sparks 1, ll. 5-6, 16-25, 30-31. Sparks discloses a shank 1 united by a ferrule 2 to a handle comprised of a U-shaped handle bar 3 and a hand piece 4. Sparks 1, ll. 35-39; fig. 1. Ferrule 2 is shaped as an inverted cylindrical cup having a closed upper end 6 forming a transverse groove 7 with a nearly semi-circular cross section. Sparks 1, ll. 44-52. The portion of bar 3 fitting into groove 7 has a complementary nearly semi-circular cross section so that bar 3 fits snugly within groove 7. Sparks 1, ll. 52-55. A bolt or rivet 8 passes through aperture 9 of bar 3 and aperture 10 of ferrule 2, firmly locking ferrule 2 to bar 3 so as to prevent rotation of bar 3 with respect to ferrule 2. Sparks 1, ll. 55-65; figs. 1-3.

We fail to see, and the Examiner has not adequately explained, how Sparks's use of a connector (rivet 8) to lock an arm portion (shank 1 and ferrule 2) to a handle (bar 3 and hand piece 4) so as to prevent rotation would provide a reason to add such a connector to the combined Sadow and Liang device where the handle is intended to pivot (rotate) with respect to the arm portion. Similarly, the Examiner's rationale that such a modification would "enable one to install the handle properly" (Ans. 4) is unpersuasive. While Sparks's connector (rivet 8) is attached using minimal parts and labor, we fail to see how knowing this method of non-rotatable attachment would instruct a person of ordinary skill in use of the connector for a rotatable attachment as claimed.

Given our analysis of the two modifications, we find that the proposed combination is not based upon a sufficient reason with a rational

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underpinning to explain why a person of ordinary skill in the art would have modified the device of Sadow to reach the subject matter of claim 30. The rejection of claims 34, 35, and 38-47 is also in error due to their dependence, directly or indirectly, from independent claim 30.

The rejections of claims 32 and 33, and claims 48-50, are based on the same proposed combination of Sadow, Liang, and Sparks as the rejection of claim 30, with further modifications based on either Browning or Miyoshi. The Examiner does not use either Browning or Miyoshi to correct the deficiencies of the Sadow, Liang, and Sparks combination. Thus, we find that the rejections of claims 32, 33, and 48-50 are in error for the reasons explained in the analysis of independent claim 30, *supra*.

DECISION

We REVERSE the Examiner's decision to reject claims 30, 32-35, and 38-50.

REVERSED

nhl

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